



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/660,054	09/11/2003	Shigeru Yamane	MAT-8260US1	7291
23122	7590	03/04/2005	EXAMINER	
RATNERPRESTIA			DIXON, MERRICK L	
P O BOX 980			ART UNIT	
VALLEY FORGE, PA 19482-0980			PAPER NUMBER	
			1774	

DATE MAILED: 03/04/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

15

Office Action Summary	Application No.	Applicant(s)	
	10/660,054	YAMANE ET AL.	
	Examiner	Art Unit	
	Merrick Dixon	1774	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 11 September 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 37,40,41,44,47,53,59,66,69,70,73 and 76 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 37,40,41,44,47,53,59,66,69,70,73 and 76 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

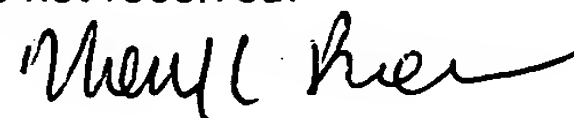
Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.



MERRICK DIXON
PRIMARY EXAMINER

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>see office action.</u> | 6) <input type="checkbox"/> Other: _____ |

Art Unit: 1774

15

Per Amdt. Filed 9-11-2003, claims 37,40,41,44,47,53,59,66,69,70,73 and 76 are pending in the instant case.

The instant office action contains Initialed , signed PTO-1449.

16

Claims 37,40,41,44,47,53 and 59 are product by process claims.

Product by process claims are based on product itself eventhough such claims recite process steps and thus the products in such claims are unpatentable if they are the same as, or, obvious from, the product of the prior art, even if the prior product was made by different processes. In re Thorpe et al, 227 USPQ 964(1985); In re Marosi 218 USPQ 964(1985). See MPEP 706.03(e).

17

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

18

Claims 37,40,41,44,47,53, 59 , 66 and 76 are rejected under 35 U.S.C. 102(b) as being anticipated by Nakatani et al(US 6096411).

The cited reference teaches the claimed invention comprising a clad board- col 2, lines 23-64; see entire reference.

19

Art Unit: 1774

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

21

Claims 66,69,70,73 and 76 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nakatani et al(US 6096411) alone.

The cited reference substantially teaches the claimed invention- col 7, lines 54-62; col 8, lines 9-20; col 7, lines 64-66; col 9, lines 9-19; col 16, lines 11-20. while the reference is silent in regards to having the additional layer material be same as the impregnating resin material, it is submitted that the cited reference's would indeed be constructed as claimed, in the absence of unexpected results. This is clearly seen in col 8, lines 55-64. here the paste impregnates the substrate and forms on either sides thereof. Concerning claims 69,70 and 73, likewise, it would have been obvious to the skilled artisan to manipulate the respective densities of the material via manipulation/working the respective layers/substrate- col 6, lines 11-19.

22

Applicants who wish to send a facsimile (draft copies) for the examiner's immediate review can do so by using the Examiner's personal fax number at 571-273-1520. The faxing of all papers must conform with the notice published in the Official Gazette, 1096 O.G. 30 (November 15, 1989). **NOTE: All facsimiles sent to the examiner's**

Art Unit: 1774

personal fax number should be in draft-forms and will be treated as informal.

**Same facsimiles will not be entered in the related applications unless
otherwise agreed and noted by the examiner.**

The fax number for all other fascimile is 703-872-9306.

Information about **the status of an application** may be obtained from the Patent
Information Retrieval system (**Private PAIR**).

Status inquiries for **published applications** may be retrieved from either **Private PAIR**
or **Public PAIR**. Questions about the PAIR system should be directed to the Electronic
Business Center at **866-217-9197**.

Any questions concerning the instant communication should be directed to Examiner
Dixon, at 571-272-1520, Mondays to Thursdays, between 12 noon and 8 PM, eastern
time . The examiner's supervisor, Mrs. Rena Dye, can be reached at 571-272-3186.



Merrick Dixon

Primary Examiner

Group 1700